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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN WIRTH, JR., JAY L. SANGER,
PAUL BRUTSMAN, and DAN STOOPS

Appeal 2009-000648
Application 10/696,587
Technology Center 3700

Oral Hearing Held: June 10, 2009

Before JENNIFER D. BAHR, STEVEN D.A. McCARTHY, and KEN B.
BARRETT, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

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P R O C E E D I N G S

1
2 MS. BOBO-ALLEN: Calendar no. 21, appeal no. 2009-0648,
3 Ms. Lester.

4 JUDGE BAHR: Good morning, Ms. Lester.

5 MS. LESTER: Good morning. Do you need a business card?

6 REPORTER: If you could, yes.

7 JUDGE BAHR: You can get started whenever you're ready.

8 MS. LESTER: Okay. All right, the case that I'm here to talk about
9 today relates to what we call a push block, and it's used to advance a work
10 piece past wood-working equipment, like a router or a table saw, anything
11 that could potentially remove a finger or a part of your hand. It's best to
12 keep your hand away from it, but the piece does need to be pushed pretty
13 hard to keep some tolerance control when you're doing the cutting.

14 And, historically, there have been a couple of different types of push
15 sticks or push blocks. One type is designed to be just put flat, right on top of
16 the piece of wood, or whatever, to push it forward. The second type has a
17 notch in it, so you can basically sit it against the back edge of the work
18 piece, to sort of finish the work. And, typically, what a woodworker had to
19 do, was use the flat plank for the initial advancement, and then as you got to
20 the end of it, you had to switch which one you were using to finish the job.
21 The problem is, when you're in the middle of cutting, you don't really want
22 to lose your control on the work piece that's going through because it can
23 shift or lift, and that will disrupt your cutting process.

24 So, the Inventers in this case came up with a push block that can act in
25 both ways. You can have it just flat on top of the work piece as you're

1 pushing the board, and you just lift it slightly and pull it back and just keep
2 doing it, so you don't lose total control. You might not have full grip the
3 whole time, but you are able to advance it along. And then, as you get to the
4 edge, you just slide it back over the edge, and a retractable heel drops down
5 from the main body of the push block, and then that will serve as your ledge
6 to push along the back of the work piece.

7 So, as it has been set forth in claim 1, and claim 5 is very similar to
8 claim 1, the push block has been characterized, first of all, as for advancing
9 the work piece past woodworking equipment. It's characterized as having a
10 main body that has a first working surface, which is what you put against the
11 top of the work piece, as having a handle component, which is vertically
12 above the main body.

13 JUDGE McCARTHY: Counsel, is the term handle component
14 defined formally anywhere in the specifications?

15 MS. LESTER: We haven't sent forth any specific definition, other
16 than what would be the customary and ordinary usage of that term.

17 JUDGE McCARTHY: Can you give us some idea of what, in your
18 opinion, would be the ordinary and customary definition of a handle
19 component?

20 MS. LESTER: Well, in my view, and I drafted the application, I was
21 thinking in terms of something that is designed to be grasped by hand, such
22 as, I mean I can pick up this, okay, and I can hold it with my hand, but this
23 doesn't have a handle. No part of this is any different than any other part.
24 But my purse, even though I can grab it by this, it does have a part of it that's
25 specifically designed to be grasped by hand. So I think that's what our

1 thinking was, is that, you know, hands are such that you can grab onto just
2 about anything, but that doesn't mean that what you're grabbing on is a
3 handle, even if conceivably you might be using it as a handle.

4 And one of the points that I'll be making is that we actually have
5 several aspects where we think the Examiner's rejection is weak. But even
6 if, a shoe upper can be a handle, even if someone might stick a shoe on a
7 work piece as you're advancing it past woodworking equipment, the shoe
8 that the Examiner cited against our push block doesn't have a second
9 working surface defined in a plane outside of the angle to the first working
10 surface of the main body. And so, even if a handle could be anything that
11 could be grasped by hand, as apparently the Examiner has construed, there
12 are limitations in the claims that we feel are not met by the shoe.

13 JUDGE McCARTHY: Counsel, looking at the Sizemore reference,
14 why wouldn't the surface six at the front end of one of the cleats or -- I'm not
15 sure what the term he used says here.

16 MS. LESTER: I think they call them retractable cleats or shock
17 absorbers.

18 JUDGE McCARTHY: That the surface at the front end of the shock
19 absorber be a second working surface.

20 MS. LESTER: Well, conceivably it could be pushed up against
21 something. I don't think you would because I think it would skew the
22 spring, but we have specifically claimed that the second working surface is
23 defined in a plane, which means it's flat -- yeah, I don't even want to say flat
24 -- it's in a plane or spatial --

25

1 JUDGE McCARTHY: But, counsel, wouldn't it be possible to define
2 a surface tangent with the front of the shock absorber, which would be
3 planer and which would be the direction in which something in contact with
4 the shock absorber would be pressed?

5 MS. LESTER: Well, if it does have a tangential engagement there, it
6 would be a line. That working line would exist. It wouldn't be a working
7 surface such as a plane.

8 JUDGE McCARTHY: But can't they define a tangential surface
9 which would be planer?

10 MS. LESTER: I think that a tangential surface has to be more than a
11 line.

12 JUDGE McCARTHY: Yes. I'm saying can't they define a
13 dimensionary surface which is tangential along that line, and which would
14 be your working surface?

15 MS. LESTER: You could. You could, but that wouldn't be the
16 working surface. In that instance, the working surface would be the line.

17 JUDGE McCARTHY: Well, why wouldn't that be a working
18 surface?

19 MS. LESTER: The line?

20 JUDGE McCARTHY: A tangent plane to the line.

21 MS. LESTER: Because that plane isn't doing anything. You're
22 saying that there is a plane that could intercept that front edge of the rounded
23 cleat. But that plane is not doing any work, not contacting anything. That's
24 imaginary. The only thing that's doing any work that is a surface of the
25 product is a line.

1 JUDGE McCARTHY: Yes, but if I put that shock absorber against
2 the edge of a board and pushed, it would be pushing perpendicularly to that
3 tangent plane.

4 MS. LESTER: But, however, the tangent plane would be the plane of
5 the board. It wouldn't be -- the cleat that you're talking about wouldn't have
6 a surface contacting it. It would be a line.

7 JUDGE McCARTHY: But it would define that surface, in the sense
8 that there is only one tangential surface to that particular edge.

9 MS. LESTER: There is only one tangential surface, but that's not the
10 working surface of the push block, or the shoe in your example. I guess
11 that's where -- I mean it's true that, okay, let's say this is your work piece,
12 and you have the rounded cleat. Okay, it's contacting a surface of the wood.
13 It's tangential. That surface is tangential to your cleat. But your cleat
14 doesn't have a working surface to find in a plane. It's curved.

15 JUDGE BARRETT: Counsel, where -- what language in the claim
16 are you getting that the second working surface has to be a plane? If I
17 understand you correctly.

18 MS. LESTER: Okay. Well, there are two things. One is the wording
19 of the claim, and, also, the Examiner has actually understood it exactly the
20 same way, but apparently overlooked the fact that we said plane in the claim.
21 What we have here -- okay, we haven't even said -- okay, a heel defining a
22 second working surface, disposed in a second plane, defined at an angle with
23 respect to the first working surface. So we've said that we have a second
24 working surface, disposed in the plane, defined at an angle. So we have a
25 surface and it's disposed in a plane. So --

1 JUDGE BARRETT: So the tangential line, isn't that a surface
2 disposed in a plane?

3 MS. LESTER: I guess I'm disagreeing that a line is a surface. I
4 guess, you know -- I mean I --

5 JUDGE BARRETT: But a cleat will contact the wood.

6 MS. LESTER: I guess that's a point where, you know, people can
7 choose to differ. I think that what we're trying to look here is at the -- you
8 know, there are only so many ways you can characterize a surface or a
9 plane, and you're basically relying on someone skilled in the woodworking
10 art, because that's the field to which this is directed, understanding the
11 structure that we are defining by these words. So I guess one could say in a
12 claim, "We're having a surface that's more than just a line, that extends
13 dimensionally," and we've done that in claim 15. We say it extends with --
14 that surface extends width-wise. So we're saying we've got to have a width
15 to it, in that plane, that surface that is defined in a plane, extends width-wise
16 of the shoe.

17 But if you look at what the Examiner has said in his Answer regarding
18 claim 15, he actually was kind enough to give us an illustration. On page 9
19 of his Answer, he has pointed to this -- the curved surface, and he says, "A
20 second working surface, having a curved surface." That's how he is
21 characterizing the cleat of Sizemore, as having a curved second working
22 surface, and he says that reads on my claimed invention, because he says on
23 the preceding page that my argument about it extending width-wise is not
24 persuasive since, "Applicant does not define whether the second working
25

1 surface is a plane surface or a curved surface." But I did in claim 1. We're
2 talking about claim 15 here, which is a dependent claim.

3 So he has overlooked the fact that I said it's disposed in the plane. He
4 said, "Well, you haven't said whether it's in a plane or a curve." The
5 reference has a curved working surface, and he has interpreted it as reading
6 on our claims, because he doesn't recognize we've already said it's disposed
7 in a plane.

8 So I mean he was understanding a surface to be more than a line. I
9 think that's how, when you have a working surface, we're not saying a
10 working line or a working contact, we're saying a surface, and that's how
11 we've tried to define it. But we do, as I mentioned, have several dependent
12 claims.

13 So if, you know, minds choose to differ on what the terminology
14 means, and I still believe that a fair reading by one skilled in the art would
15 understand a surface, a working surface disposed in a plane, at an angle to
16 the first working surface, which we've also characterized in a plane, would
17 understand we are talking about more than a line.

18 But we do have, for example, in dependent claim 15, that the second
19 working surface disposed in a plane extends width-wise and faces the
20 leading half of the push block. I almost said shoe. And then we also have,
21 in claim 11, we've said that there is a retaining plate that -- and to quote the
22 terminology exactly, because I think the words are important -- we have a
23 retention plate for securing said retractable heel to said main body. The
24 Examiner has cited, I don't know what you would call it, I think he has
25 called it a protective plate, but he hasn't labeled it in figure 3, which is what

1 I'm looking at right here, but it's right about three, which has his retractable
2 cleats. And the Examiner has said that that reads on our retention plate.
3 And we've said well this doesn't do anything to secure the retractable cleats
4 of his to the main body three, as he has characterized it. And the Examiner's
5 answer was "Well, it prevents the springs and the cleats from popping up
6 into the individual's foot." Well, we haven't said that it retains the
7 retractable cleats in place. We haven't said it prevents them from going up
8 into a foot. What we've said is that it is for securing them in place. And
9 there is no securing structure or function whatsoever. It's simply some sort
10 of a backing plate that Sizemore has provided. So we also believe that claim
11 11 describes specific structure having a function and a structural relationship
12 to the other components, which isn't met by Sizemore.

13 Each of these claims -- there is also claim 5, where we have talked
14 about a slip-resistant pad being over-molded to -- or secured, actually, is
15 what we've said. Over-mold is the dependent claim. Claim 5, we said we
16 have at least one slip-resistant pad secured to either the first working surface,
17 the second working surface, or both. The Examiner has cited a secondary
18 reference to Misevich as having a non-slip pad. But the non-slip pad that
19 Misevich provides is for preventing an insole from slipping, so you don't
20 have to glue the insole in place. So it's completely within the confines of the
21 shoe. It's either provided on the top of the shoe bottom or the bottom of the
22 shoe insole, but it's within the shoe. There's no teaching of providing it on
23 Sizemore's first or second working surfaces, however you might define those
24 surfaces.

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1 And then, we also have claim 16, where we've said that our push
2 block main body and handle are molded from a plastic material. Now,
3 Sizemore says that his shoe can be made from any material suitable for that
4 type of shoe, and he mentions, I think, leather and rubber, or he might have
5 mentioned canvas, but I can't recall. But he does mention leather, which we
6 would understand, to talk about the shoe upper when you're talking about an
7 athletic-type shoe that he illustrates, and rubber, as you might understand,
8 for a sole. Well, the Examiner said, "Well, rubber is plastic," and I've found
9 another reference, Hammerschmidt, that is a plastic clog that's molded. So if
10 Sizemore says you can make your product from plastic, you would mold it.
11 Well, Sizemore never says you can make it from plastic and rubber is not
12 plastic, and --

13 JUDGE McCARTHY: Well, why wouldn't rubber be a plastic, a
14 polymer?

15 MS. LESTER: Rubber is from a rubber tree.

16 JUDGE McCARTHY: Synthetic rubbers are polymers.

17 MS. LESTER: Well, he doesn't say synthetic rubber. And synthetic
18 rubber is a misnomer. It's not rubber. It's a plastic. So I guess, again, my
19 point is, the fact that there's a plastic clog out there somewhere in the world,
20 doesn't mean you would make Sizemore from molded plastic. Sizemore
21 tells the skilled artisan you're going to make it from what you would
22 conventionally make a shoe from.

23 But, again, I mean it goes back to the fact that we really -- we're
24 talking about a push block for pushing a work piece past a piece of
25 woodworking equipment, and we've got two working surfaces, and we've

1 got a main body and a handle and we're molding them from plastic. You
2 know, the Examiner is, I think, building on the fact that he thinks he has met
3 all the limitations of our main claim, which we would take issue with. We'd
4 also take issue with claim 15 being rejected under 102.

5 JUDGE McCARTHY: Counsel, turning back to your main claim.

6 MS. LESTER: Yes.

7 JUDGE McCARTHY: If I understand correctly, the Examiner has
8 taken the position that the shoe upper is the handle component. And I'm
9 wondering why it is that a shoe upper could not be used, if one were to reach
10 the hand into the through of the shoe and grab the top and bottom of the shoe
11 upper, why that would not act as a handle?

12 MS. LESTER: Well, as I said, I mean I can take my shoe off, okay?
13 You could stick your shoe in here. Well then, you're not grabbing on to
14 anything if you're doing it like this. So I think --

15 JUDGE McCARTHY: Well then, reach your hand in the other way
16 and you can grab it.

17 MS. LESTER: Or I can go like this. And, like I said with my other
18 examples, a shoe upper is not designed as, construed by the ordinary artisan
19 as, or intended to be grasped like a handle. You can grab onto anything.

20 JUDGE McCARTHY: But did you really look at that intention, or
21 what something is designed for, in determining whether or not we have an
22 anticipation, or --

23 MS. LESTER: Well, and that's why I said -- I feel that this is not
24 designed to be, structurally considered to be, or would be interpreted by the
25 skilled artisan to be, a handle. However, if you do accept that someone

1 would use a shoe as a push block, and would grab the upper as a handle to
2 operate it, what's still lacking is a second working surface, defined in a
3 plane, at an angle to the first working surface. So I'm not going to belabor
4 the handle issue. Because I can grab it by hand, I don't think it would be
5 understood to be a handle. If I asked anyone out on the street, pointing to a
6 shoe, "Where's the handle?" I don't think that they would consider it to have
7 a handle, because that's not the ordinary and customary usage of the product,
8 nor even a reasonable usage of the product.

9 But, beyond that, what I would go to -- if that is not, you know,
10 agreed to, I'm not going to belabor it. But I do feel very strongly that even if
11 that isn't considered to be lacking, the second working surface, as we've
12 defined it, is lacking.

13 And, beyond that, we have dependent claims that have been rejected.
14 Also, as anticipated, the retention plate of claim 11 is not there functionally
15 or structurally. And, in 15, a second working surface, disposed in a plane,
16 extending width-wise of the main body, is also lacking. And that has also
17 been rejected in 102.

18 So I think the anticipatory rejection, even if it is considered to stand
19 with respect to claim 1, which we don't feel is appropriate, but if that
20 happens, we still feel that we do have dependent claims that in Brief, and in
21 the Reply Brief, we've pointed out where the anticipatory requirements of
22 102 are not met.

23 JUDGE BAHR: Any more questions?

24 I think we understand your position.

25 MS. LESTER: Okay.

1 JUDGE BAHR: Thank you.

2 (Whereupon, the hearing concluded on June 10, 2009.)

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